

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Takuya Tamatani et al.	Art Unit :	1644
Patent No. :	7,294,473	Examiner :	Ilia I. Ouspenski
Issue Date :	November 13, 2007	Conf. No. :	1646
Serial No. :	10/721,404		
Filed :	November 25, 2003		
Title :	METHODS OF IDENTIFYING SUBSTANCES THAT INTERACT WITH JTT-1 PROTEIN		

Commissioner for Patents  
P.O. Box 1450  
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APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. This application is being filed together with a petition under 37 C.F.R. § 1.183 for a suspension of the two month time limit specified under 37 C.F.R. § 1.705(d).

Reconsideration of the final PTA calculation to increase total PTA from 444 to 747 days, is respectfully requested.

REMARKS

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth et al. v. Jon W. Dudas (U.S. District Court, D.C., CA No. 07-1492, Mem. Op. September 30, 2008), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

**CERTIFICATE OF MAILING BY EFS-WEB FILING**

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: January 22, 2009

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years.” “B delay” begins only after the PTO has failed to issue a patent within three years, not before. Id.

#### REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

##### “A Delay”

A first PTO action was due on or before January 25, 2005 (the date that is fourteen months after November 25, 2003, the date on which the application was filed). The PTO mailed the first non-final Office Action on April 14, 2006, thereby according a PTO Delay of 444 days. Patentee does not dispute the PTO’s calculation for this “A Delay” from January 26, 2005 (the day after the date that is fourteen months after the date on which the application was filed), to April 14, 2006. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

In view of the period of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 444 days.

##### “B Delay”

The period beginning on November 26, 2006 (the day after the date that is three years after the date on which the application was filed), and ending November 13, 2007 (the date the patent was issued), is 353 days in length.

“B Delay” may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. In the present application, a Notice of Appeal was filed on May 23, 2007, and a Notice of

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Allowance was mailed by the PTO on July 11, 2007. See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

As a result of the required exclusion from "B Delay" of the period from May 23, 2007, to July 11, 2007, "B Delay" accumulated during the follow periods: (i) November 26, 2006, to May 22, 2007 (178 days); and (ii) July 12, 2007, to November 13, 2007 (125 days).

In view of the periods of "B Delay" detailed above, the total "B Delay" for this patent should be calculated as 303 days (i.e., the sum of 178 days and 125 days). The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 303 days.

#### Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following period:

January 26, 2005, to April 14, 2006.

As detailed above, "B Delay" accumulated during the following periods:

November 26, 2006, to May 22, 2007; and

July 12, 2007, to November 13, 2007.

The "A Delay" and the "B Delay" overlap (i.e., occur on the same calendar day) for a total of 0 days.

#### Applicant Delay

There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the application as set forth 37 C.F.R. § 1.704.

#### Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

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### Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 444 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 747 days (i.e., the sum of 444 days of "A Delay" and 303 days of "B Delay" minus the 0 days of overlap);
- 2) Total Applicant Delay should be calculated as 0 days; and
- 3) Total PTA should be calculated as 747 days.

Please apply the fee of \$200 required under 37 C.F.R. § 1.18(e) and any other required charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket Number 14539-0004012.

Respectfully submitted,

Date: January 22, 2009

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